

**REMARKS**

Applicant has carefully reviewed the Office Action dated December 24, 2003. Claim 1-22 are pending in this application. Applicant has amended Claims 1 and 12 to more clearly point out the present inventive concept. Reconsideration and favorable action is respectfully requested.

Claims 12-22 stand rejected under 35 U.S.C. §102(e) as being anticipated by *Ogasawara*. This rejection is respectfully traversed with respect to the remaining claims.

The operation of the Applicant's present concept was defined in the last response and is applicable hereto. In general, the *Ogasawara* reference lacks a few aspects of Applicant's Claim 12. First, Applicant's Claim 12 requires that there be some identification device for associating unique identification information with the extraction operation of said extraction circuit. The extraction circuit having the unique identification information is set forth more clearly in claim 17, but the unique identification information is certainly set forth in the claim as being associated with the extraction operation of the extraction circuit. In *Ogasawara*, there is provided a unique terminal ID and a customer ID which is unique to that customer, this being issued to the customer when the customer enters the store. However, Applicant believes that the system of *Ogasawara* does not associate the unique identification information with the extraction operation. The only disclosure as set forth is that whenever a communication is made, there is an allowance made to identify both the terminal and the user. However, there is no association between that identification and the actual extraction operation itself. Further, there is no disclosure in *Ogasawara* that sets forth the limitations of line 15-20 in Claim 12 as previously presented. This basically does not provide any disclosure that utilizes the scanning operation to both extract the encoded information therefrom, i.e., scan the MRC code, associate that decoded information with the unique information associated with the user and then complete the transaction. This is all in response to and as a result of the scanning operation. As such, even though there may be an argument that software modifications could be made to the system of *Ogasawara*, the mere fact of having a processing system with a terminal ID and the ability to identify the user by a user

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ID does not suggest or motivate one to further modify the operation thereof to provide an apparatus with an associated functionality that would read on the claim limitations of Claim 12. As such, Applicant does not believe that independent Claim 12 was anticipated by *Ogasawara*. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §102 rejection with respect to Claim 12. With respect to Claims 13-22, they are dependent from Claim 12, and therefor, for the reasons described above with respect to Claim 12, they are also believed to not be anticipated by *Ogasawara*. Applicant respectfully requests withdrawal of the 35 U.S.C. §102 rejection with respect to Claims 13-22.

The Examiner has rejected claims 1-5 and 12-16, alternatively, under 35 U.S.C. §102(e) being anticipated by *Barnett*. This rejection is respectfully traversed.

As noted in the previous response, Applicant believes that in the specification of *Barnett* they lack the ability to provide the unique information associated with the portable unit. As noted in the previous response, there is no disclosure that unique identification information associated with the user is in any way associated with the step of extracting, nor is there any disclosure that the operation of extracting information in the MRC code in any way allows the transaction to be completed in response to the extraction operation. As such, Applicant respectfully requests withdrawal of the 35 U.S.C. §102(e) rejection with respect to claims 1-5 and 12-16 in view of *Barnett*.

Claims 1-11 stand rejected under 35 U.S.C. §102(e) as being anticipated by *Ogasawara*. The Examiner has taken the position that the method set forth in Applicant's claim is "inherently disclosed." The Examiner states that the inherency is due to the fact that the *Ogasawara* device, "in its normal and usual operation" would necessarily perform the claimed method. Applicant believes that a reading of *Ogasawara* does not show that the apparatus of *Ogasawara* is in any way programmed to function to carry out the steps set forth in the amended claims. Applicant appreciates the fact of the Examiner's argument in that computers and retail systems and such that possess the "capability" to perform certain functions might, once programmed, be considered to be capable of carrying out the method steps. However, it is Applicant's position that just because the capability exists for a system to functionally carry out certain steps once given that functionality, absent a motivation or suggestion that one would

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program such system to carry out these steps is difficult to read into any system. As such, Applicant takes the position that there is no disclosure in *Ogasawara* that would lead one to consider that the steps set forth in independent Claim 1 are within the normal and usual operation of the *Ogasawara* device and, therefore, would not be steps that would be anticipated or obviated by the disclosure in *Ogasawara*. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §102(e) rejection with respect to claims 1-11.

*During litigation only*

The Examiner has again asked Applicant to confirm Applicant's position that he will be his own lexicographer. Applicant noted in the previous response that it is believed that the claims can clearly be interpreted in view of the specification. Certainly, the claims can be read without the specification unless necessary. If there is an ambiguity or something that is unclear, the specification can be utilized to further interpret the claims. If there is an ambiguity that cannot be cleared up with a review of the specification, then possibly either a clarification by Applicant's attorney, the undersigned, or an amendment may be appropriate. However, unless such is the case, Applicant does not believe that it is necessary to further interpret the claims. Applicant hopes that this clarifies this matter somewhat.

Claims 12-22 stand rejected on 35 U.S.C. §103(a) as being unpatentable over *Ogasawara*. This rejection is respectfully traversed with respect to the amended claims for the reasons described herein above. With respect to the 35 U.S.C. §102 rejection, *Ogasawara* does not rise to the level of an anticipatory reference. However, there are steps in Applicants method claims and functional aspects of the apparatus claims that are neither suggested nor disclosed in *Ogasawara* such that one skilled in the art would be motivated to modify *Ogasawara* to perform such steps or to provide such claimed functions. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection with respect to claims 12-22.

Claims 1-11 stand rejected on 35 U.S.C. §103(a) as being unpatentable over *Ogasawara*. This was primarily for the reason that the Examiner considers that method Claims 1-11 are not patently distinct from apparatus Claims 12-22. However, each of the claims stands on their own and again, Applicant believes that *Ogasawara* does not provide any motivation or suggestion of the claimed steps

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as set forth herein above. Therefore, Applicant respectfully requests withdrawal for 35 U.S.C. §103(a) rejection with respect to Claims 1-11.

The Examiner has noted that there is "intended use" language for the apparatus. However, Applicant notes that these types of machines, i.e., computers have no use unless they are programmed. Therefore, a computer does not have any use until it's programmed. However, once programmed, it can functionally operate in a significantly different manner than another computer. The apparatus is no different with the exception of the program code that is embedded therein. Once the program code is provided then it is an entirely and functionally different apparatus that can perform different functions. Therefore, Applicant believes that it is not a recitation of use of a product but, rather, it is a fact that once the program is provided with a functional nature, it is actually a different apparatus and, therefore, Applicant believes that the functional aspects of the apparatus are not superfluous to the claimed language, but inherently defined the apparatus.

The Examiner has expressed a concern about whether Applicant is deciding not to be his own lexicographer by indicating and defining claim limitations defining things other than the ordinary and customary meanings. Applicant again notes that the claims should be interpreted with meanings that can be determined from the ordinary meaning of such terms. If Applicant were to define an element as being a "diode" in a claim, Applicant believes that the specification would certainly not define a diode as being anything other than what it clearly is. These are clearly defined terms within the industry and should be given their interpretation as such. If there is a term that is, again, ambiguous, then that would require clarification. Applicant does not believe that there are any ambiguous terms in the claims. However, such terms as "extraction circuit" in the claims would require a review of the specification to determine exactly what an extraction circuit would be. If such is the case and the Examiner requires Applicant to expressly define what that is, Applicant is willing to do so. However, there are certain terms in the claim that do not require a review of the Specification for such interpretation. Applicant respectfully notes to the Examiner that the undersigned is unclear as to exactly what the Examiner wants. Certainly, Applicant's attorney does not have a desire to restrict each and every element of claim by the specific disclosed embodiment. For example, if Applicant had claimed in an electronic

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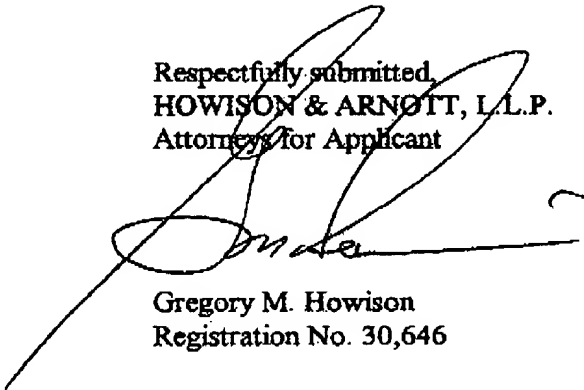
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application a "silicon diode," Applicant would not want the claim language of a "diode" to interpret it so as to rule out the use of a germanian diode or any such rectifier. Applicant apologizes for this confusion and possibly a telephone conference between the Examiner and Applicant's attorney would be useful to clarify this matter.

The Examiner has indicated that the term "means" in the claims does not invoke 35 U.S.C. §112 Paragraph 6. Applicant believes that this clearly is means plus function language since there is the clause "means for" followed by functional language. As such, Applicant believes that the language expressly sets forth means plus function limitations and should be treated accordingly.

Applicant has now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicant respectfully requests full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/PHLY-25,357 of HOWISON & ARNOTT, L.L.P.

Respectfully submitted,  
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